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10/677,555	10/02/2003	William J. Purcell	QINT-0015	9541
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WOODCOCK WASHBURN LLP CIRA CENTRE, 12TH FLOOR 2929 ARCH STREET PHILADELPHIA, PA 19104-2891			GOLDMAN, MICHAEL H	
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/677,555	<b>Applicant(s)</b> PURCELL ET AL.
	<b>Examiner</b> Michael H. Goldman	<b>Art Unit</b> 4127

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If no period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED. (35 U.S.C. § 133).

Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 28 January 2008.

2a) This action is FINAL.      2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1-23 is/are pending in the application.

4a) Of the above claim(s) 11-23 is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 1-10 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on 10-02-03 is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All    b) Some \* c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) Notice of References Cited (PTO-892)

2) Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) Information Disclosure Statement(s) (PTO/06/08)  
Paper No(s)/Mail Date 8-02-04

4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date: \_\_\_\_\_

5) Notice of Informal Patent Application

6) Other: \_\_\_\_\_

### **DETAILED ACTION**

1. This communication is a first Office Action Non-Final on the merits. Claims 1-23, as originally filed, are currently pending and have been considered below.

#### ***Election/Restrictions***

2. Applicant's election without traverse of claims 1-23 in the reply filed on 1-28-2008 is acknowledged.
3. Claims 11-23 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to the nonelected groups II and III, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 1-28-2008.

#### ***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
5. **Claims 3-5 and 6-8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.**

In claim 3, line 1 claims "the physical location". There is insufficient antecedent basis for this limitation in the claim.

In claim 4, line 2 claims "the store". There is insufficient antecedent basis for this limitation in the claim.

In claim 5, line 1 claims "the directions". There is insufficient antecedent basis for this limitation in the claim.

In claim 6, line 1 claims "the act". There is insufficient antecedent basis for this limitation in the claim.

In claim 6, line 2 claims "the retailer". There is insufficient antecedent basis for this limitation in the claim.

In claim 8, line 1 claims "the item record". There is insufficient antecedent basis for this limitation in the claim.

***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. **Claims 1 and 2 are rejected under 35 U.S.C. 102(b) as being anticipated by Engel et al. (5907830).**

**As per claim 1, Engel et al. discloses a method of providing to a user comprising:**

providing the user with the promotion (see Fig 1. whereby coupon host computer via network provides coupon to client/user at client printer);

determining whether the user has selected the promotion (see page 1, column 2, lines 10-12 whereby the coupon identification incorporates the client computer's address and the date to prevent unauthorized duplication, examiner

construes coupon with client computer address and date as unique/one of a kind coupon, examiner further construes determination whether user has selected the promotion via unique coupon redemption);

if the user has selected the promotion, informing a retailer about the selected promotion (see page 3, line 4 whereby the distribution and certificates including their retail redemption can be tracked; and lines 7-8 whereby the site at which the coupons are redeemed, examiner construes site as retailer location);

determining whether the selected promotion is being redeemed at the retailers (see page 3, line 4 whereby the distribution and certificates including their retail redemption can be tracked, examiner construes as determining whether the selected promotion is being redeemed at the retailers);

if the selected promotion is being redeemed at the retailer, determining whether the selected promotion corresponds to the promotion being redeemed (see page 3, line 4 whereby the distribution and certificates including their retail redemption can be tracked, examiner construes as selected promotion corresponds to promotion redeemed);

if the selected promotion corresponds to the promotion being redeemed, providing the user with the promotion (see page 3, lines 7-8 whereby based on information encoded on the coupons *and the site at which the coupons are redeemed*, examiner construes the corresponding encoded information with the actual site at which the coupon(s) are redeemed as having provided the user with the promotion).

**As per claim 2**, Engel et al. discloses a method further including the act of providing the user with a promotion receipt (see FIG. 1 whereby client printer provides a printed promotion, examiner construes as receipt).

***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

9. **Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Engel et al. in view of Denimarck et al (20030018522).**

**As per claim 3**, Engel et al. discloses the invention described above. However, Engel et al. fails to disclose wherein the promotion receipt indicates the physical location of an item corresponding to the promotion.

Denimarck et al. discloses a method that facilitates the customer's shopping experience such as coupons and a map showing the physical location of shopping items (see abstract lines 8-11).

Both Engel et al. and Denimarck et al. disclose a method for facilitating the customer's shopping experience by providing coupons. Therefore, it would have been obvious to one skilled in the art at the time of the invention to modify the coupon method of Engel et al. to include a method for providing the physical location of shopping items as taught by Denimarck et al. in order to facilitate completing the shopping experience and the completing the transaction.

**10. Claims 4 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Engel et al. in view of Denimarck et al. (20030018522) as applied to claim 3 above, and further in view of Spitzer (20010054066).**

As per claim 4, the combination of Engel et al. and Denimarck et al. discloses the invention described above.

However, the combination of Engel et al. and Denimarck et al. fails to disclose wherein the promotion receipt includes directions to the store carrying an item corresponding to the promotion.

Spitzer discloses a method that facilitates the customer's experience using downloaded coupons which includes directions to the store (see [0076], lines 16-17 downloaded the coupon on the PDA, also see [0085], lines 2-4, whereby providing a user who downloaded a coupon easy access to the store, also see [0085], lines 10-11 whereby included with the information, can be directions to the store).

Both the combination of Engel et al. and Denimarck et al., and Spitzer disclose a method for facilitating the customer's shopping experience by

providing coupons. Therefore, it would have been obvious to one skilled in the art at the time of the invention to modify the coupon method of the combination of Engel et al. and Denimarck et al. to include a method for providing the directions to the store for the item(s) as taught by Spitzer in order to facilitate completing the shopping experience and the completing the transaction.

**As per claim 5,** the combination of Engel et al. and Denimarck et al. discloses the invention described above.

However, the combination of Engel et al. and Denimarck et al. fails to disclose wherein the directions are selected from a group comprising maps and URLs.

Spitzer discloses a feature that facilitates the customer's experience using downloaded coupons which includes maps and URLs (see [0065], lines 3-6 whereby the user physically goes to a retailer whose coupon has been transmitted onto the user's handheld device, such as a PDA, also see [0061] line 16 provides access to Maps via PDA, also see [0009], lines 11-12 whereby one would enter the URL for that website into the hand held device).

Both the combination of Engel et al. and Danimarck et al., and Spitzer disclose a method and features for facilitating the customer's shopping experience by providing coupons. Therefore, it would have been obvious to one skilled in the art at the time of the invention to modify the coupon method of the combination of Engel et al. and Danimarck et al. to include the features for providing maps and URLs with respect to the store for the item(s) as taught by

Spitzer in order to facilitate completing the shopping experience and the completing the transaction.

**11. Claims 6-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Engel et al. (5907830) in view of Liu et al. (20050075926).**

As per claim 6, Engel et al. discloses the invention described above.

However, Engel et al. fails to disclose the method wherein the act of informing a retailer about the selected promotion includes sending the retailer a promotion identifier.

Liu et al. discloses the method wherein the act of informing a retailer about the selected promotion includes sending the retailer a promotion identifier (see FIG. 1 and [0059], lines 6-10 whereby the data server 150 'packages' the real-time promotion parameters and provides promotion communications (see [0060], lines 8-10) to servers 130-140 (Merchant Servers); also see abstract lines 12-13 whereby code directs the processor to form a specification for the promotion in response to the promotion identifier...that directs the processor to transmit the promotion to the plurality of application servers, examiner construes server 130, merchant server as inclusive).

Both Engel et al. and Liu et al. disclose a method for facilitating the customer's shopping experience by providing coupons. Therefore, it would have been obvious to one skilled in the art at the time of the invention to modify the coupon method of Engel et al. to include the method for providing promotion

identifier information to the retailer (merchant server) as taught by Liu et al. in order to facilitate completing a secure transaction.

**As per claim 7**, Engel et al. discloses the invention described above.

However, Engel et al. fails to disclose the method wherein the promotion identifier corresponds to an item record.

Liu et al. discloses the method wherein the promotion identifier corresponds to an item record.(see FIG. 1 and [0059], lines 6-10 whereby the data server 150 'packages' the real-time promotion parameters and provides promotion communications (see [0060], lines 8-10) to servers 130-140 (Merchant Servers); also see abstract lines 12-13 *whereby code directs the processor to form a specification for the promotion in response to the promotion identifier*, examiner construes specification to correspond to an item record.

Both Engel et al. and Liu et al. disclose a method for facilitating the customer's shopping experience by providing coupons. Therefore, it would have been obvious to one skilled in the art at the time of the invention to modify the coupon method of Engel et al. to include a method for providing promotion identifier information which corresponds to an item record as taught by Liu et al. in order to facilitate completing a secure transaction.

**As per claim 8**, Engel et al. discloses the invention described in claim 7 above.

However, Engel et al. fails to disclose the method wherein the item record is stored in a database.

Liu et al. discloses the method wherein the item record is stored in a database (see [0012] lines 21-22 – that directs the processor to store the promotion specification in a database).

Both Engel et al. and Liu et al. disclose a method for facilitating the customer's shopping experience by providing coupons. Therefore, it would have been obvious to one skilled in the art at the time of the invention to modify the coupon method of Engel et al. to include a method wherein the item record is stored in a database as taught by Liu et al. in order to facilitate completing a secure transaction.

**12. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Engel et al. (5907830) in view of Gardenswartz et al. (6298330).**

**As per claim 9,** Engel et al. discloses the invention described in claim 1 above.

However, Engel et al. fails to disclose the method wherein the act of determining the selected promotion corresponds to the promotion being redeemed, which further includes:

checking a first portion of a promotion identifier;  
if the first portion of the promotion identifier matches a target code,  
extracting a second portion of the promotion identifier; and  
accessing information within an item record associated with the second portion of the promotion code and including information regarding the promotion.

Gardenswartz et al. discloses the method wherein the act of determining the selected promotion corresponds to the promotion being redeemed which further includes:

checking a first portion of a promotion identifier (see column 3, lines 31-32 – any device capable of receiving the first identifier);  
if the first portion of the promotion identifier matches a target code, extracting a second portion of the promotion identifier (see column 3, lines 34-39 – the second identifier is preferably a CID, a bar code...the registration server associates the first and second identifiers by linking the first identifier and the second identifier in a memory, examiner construes linking first and second identifiers equivalent to promotion identifier matches a target code); and  
accessing information within an item record associated with the second portion of the promotion code and including information regarding the promotion (see column 14, lines 51-54 whereby the targeted promotions or coupons are only recognized at the store where each consumer prefers to shop, examiner construes second identifier as the method of accessing the promotion code).

Both Engel et al. and Gardenswartz et al. disclose a method for facilitating the customer's shopping experience by providing coupons. Therefore, it would have been obvious to one skilled in the art at the time of the invention to modify the coupon method of Engel et al. to include a method for determining that the

selected promotion corresponds to the promotion being redeemed as taught by Gardenswartz et al. in order to facilitate completing a secure transaction.

**As per claim 10,** Engel et al. fails to disclose the method wherein the item record includes information selected from a group comprising an item code, department number, pricing method, description, manufacturer number, promotion value, limitations, and family code.

Gardenswartz et al. discloses the method wherein the item record includes information selected from a group comprising an item code, department number, pricing method, description, manufacturer number, *promotion value, limitations, and family code* (see Figure 2(b) items 34, 36 and 37, where examiner construes SKU as item code with description and manufacturer number, store/chain as department number and price as pricing method; examiner also construes selected from a group as not requiring all elements from the group.

Both Engel et al. and Gardenswartz et al. disclose a method for facilitating the customer's shopping experience by providing coupons. Therefore, it would have been obvious to one skilled in the art at the time of the invention to modify the coupon method of Engel et al. to include a method for wherein the item record includes information selected from a group comprising an item code, department number, pricing method, description, manufacturer number as taught by Gardenswartz et al. in order to facilitate completing a secure transaction.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MICHAEL H. GOLDMAN whose telephone number is (571)270-5101. The examiner can normally be reached on Monday thru Thursday 6:30am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lynda Jasmine can be reached on 571-270-3033. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Mhg

/Lynda Jasmin/  
Supervisory Patent Examiner, Art Unit 4127